

### **REMARKS**

Applicants respectfully traverse and request reconsideration.

Applicants respectfully submit that the Examiner's rejections constitute clear error because they ignore claim language and because the cited publication does not teach what is alleged.

Claims 64-105 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Publication No. 2004/0148506 A1 to Prince ("Prince"). A claim is only anticipated when each of its elements is found in a single reference. MPEP § 2131. Because the Examiner ignores claim language, and because the cited portions of Prince do not teach each element of Applicants' pending claims, there has been no showing of anticipation. Applicants further note that the advantages provided for by its claimed method and apparatus are unachievable by the Prince reference. Consequently, any rejection based on anticipation is fabricated and unsupported. Finally, Applicants submit herewith Rule 131 declarations, each signed by one of the four inventors. Each of the declarations sets forth facts showing that the claimed invention was reduced to practice prior the earliest effective date of the Prince reference, January 23, 2003.

### **CLAIM 64**

#### ***A. THE OFFICE ACTION FAILS TO CONSIDER THE INTERPLAY OF THREE ENTITIES***

Independent method claim 64 requires, among other things, the involvement of three different entities: (1) a first entity that is a provider of a first set of encoded e-mail addresses to which an e-mail message could be sent (the "Could Send List"); (2) a second entity that is a source of the e-mail message; and (3) a third entity that receives the Could Send List from the first entity, compiles a second set of encoded e-mail addresses to which the e-mail message should not be sent (the "Should Not Send List") and removes from the Could Send List, each

address on the Should Not Send List to yield a third set of encoded e-mail addresses to which the e-mail message may be sent (the “May Send List”).<sup>1</sup> Prince, however, involves only one entity, a Client. The Client is the originator of a Can Send List. The Client is the compiler of a Should Not Send List. The Client removes entries on the Can Send List that are also on the Should Not Send List to create a May Send List. Consequently, any application of Prince to claim 64 constitutes clear error.

Applicants submit that the previous Office action response filed April 29, 2008 articulated, among other points, the failure of the Office action to consider the interplay of three entities in its rejection. Again, the Office action has failed to consider or point to portions of Prince where such interplay between the three claimed entities is found or taught.

The current Office action rejects Claim 64 by citing to four paragraphs in Prince: 59, 30, 48 and 39. (Office action, pp. 2-3, 5-6). Paragraph 59 allegedly teaches the claimed method of “receiving, by a third entity, a first set of encoded e-mail messages from a first entity, wherein said first set of encoded e-mail addresses represents e-mail addresses to which an e-mail message could be sent.” Applicants, however, note that this portion of Prince merely reaffirms that Prince’s e-mail marketers use its Client Do-Not-Contact List (i.e., something similar to a Should Not Send List) using its Client Do-Not-Contact List Application to check their bulk e-mail lists (i.e., something similar to a Can Send List) to ensure its intended recipients have not requested to be kept free of so-called ‘spam’. Together with paragraph 33, paragraph 59 also suggests that Prince’s Client and Client Do-Not-Contact List Application are one-and-the-same entity such as an e-mail marketer that sends unsolicited communications or otherwise stores or uses contact

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<sup>1</sup> The terms “Can Send List”, “Should Not Send List” and “May Send List” are introduced solely for exemplary purposes and to distinguish the Prince reference. Such terms are not used in the pending application and are not offered as a definition for any pending or future claim terms.

information. Paragraph 59 gives two examples of how e-mail marketers use Client Do-Not-Contact Lists: (1) adult website stores can use its Client Do-Not-Contact List Application to check to see if the an e-mail address belongs to a minor before granting access to their site; and (2) a client (i.e., e-mail marketer) can use the Client Do-Not-Contact List Application to stop the transmission of an outgoing message if its recipient's address is on the Client Do Not Contact List. Thus, paragraph 59 also suggests that Prince's Client is the source of the e-mail message itself. Notably, this paragraph fails to teach the requisite interplay of the claimed first and third entities as required by the above-cited claim limitation. Instead, it appears that the e-mail marketers of Prince's paragraph 59 are both: (1) the source of the e-mail message (serving a function somewhat similar to the "first entity" in claim 64) and (2) the entity that removes addresses on a do not contact list (serving a function somewhat similar to the "third entity" in claim 64). This alone is clear error supporting allowance of claim 64.

Paragraph 30 allegedly teaches the claimed method of "compiling, by said third entity, a second set of encoded e-mail address, wherein said second set of encoded e-mail addresses represents e-mail addresses to which said e-mail message should not be sent." Put in context of the claim, this third entity is the same entity that receives, from the first entity, the first set of encoded e-mail addresses. Prince's paragraph 30, together with FIG. 1, appears to teach that the Client and its Client Do-Not-Contact List Application 400 acquire its Client Do-Not-Contact List from a Master Do-Not-Contact List Server 300 and database 350. (*See also* Paragraph 33 stating that "Periodically certain of the Client Do-Not-Contact List Application (400) requests new entries from the Master Do-Not Contact List Server (300). The new records retrieved from the Master Do-Not-Contact List Server (300) are combined with any old entries and sorted to create a Client Do-Not-Contact List."). In other words, paragraph 30 confirms that the Client and its

Client Do-Not-Contact List Application is the entity that creates the Client Do-Not-Contact List (i.e., something similar to a Should Not Send List). Paragraphs 33 and 59 suggest that the same entity is also the source of bulk e-mail lists (i.e., something similar to a Can Send List) and the e-mail message itself. Thus, the Office action citation to paragraph 30 supports Applicants' contention above that Prince fails to consider claim language, namely the claimed interaction between three entries.

Paragraph 48 allegedly teaches the claimed method of “removing, by said third entity, from said first set of encoded e-mail addresses, each encoded e-mail address that is in said second set of encoded e-mail addresses thereby yielding a third set of encoded e-mail addresses, wherein said third set of encoded e-mail addresses e-mail addresses to which said e-mail message may be sent, wherein a second entity is a source of said e-mail message.” Applicants again submit that paragraph 48 does not stand for the proposition proffered by the Office action. Instead, paragraph 48 teaches a concept not even tangentially related to the claim language: the ability of Prince's e-mail recipient to opt-in and request to be taken off a Client Do-Not-Contact List. In paragraph 48, Prince teaches that after “an individual has opted-in to receiving messages from a marketer”, “the marketer can remove the records matching the individual's data [e.g., e-mail address] from the Client Do-Not-Contact List.” Applicants submit that the recipient of an e-mail message is neither the same thing as the claimed first entity that provides the first set of encoded e-mail addresses to which an e-mail message could be sent (i.e., the Could Send List), nor is the recipient the same thing as the claimed second entity that provides the second set of e-mail addresses to which an e-mail message could not be send (i.e., the Should Not Send List).

In fact, Prince makes clear in Paragraphs 48, 33 and 59 that the Client (i.e., the e-mail marketer) in Prince is: (1) the source of the e-mail addresses in the bulk e-mail lists (serving a

function somewhat similar to the “first entity” in claim 64); (2) the originator of e-mail message for mass mailing (serving a function somewhat similar to the “second entity” in claim 64); and (3) the compiler of the Client Do-Not-Contact List and the entity that prohibits the mailing of messages to recipients whose addresses are on the Client Do-Not-Contact List (serving a function somewhat similar to the “third entity” in claim 64). Because claim 48 requires three separate entities, the application of paragraph 48 to Applicants’ claim constitutes clear error.

Even if paragraph 48 could somehow be interpreted to provide for or teach Applicants’ first and third entities, (a position not taken by Applicants because Prince’s recipient is, as that term plainly suggests, the recipient of an e-mail message), paragraph 48 does not cure the other deficiencies in the rejection: Prince’s e-mail marketer (i.e., Client) appears to function in a capacity similar to Applicants’ claimed third and second entities by serving as the compiler of a Should Not Send List and as the originator of the e-mail message. (Paragraphs 33 and 59). Because claim 64 requires the interplay of three entities and not just one or two entities, this again constitutes clear error.

Finally, paragraph 39 is cited as allegedly teaching, in the words of the Examiner, the “receiving by Client Do-Not-Contact Application a list of hashed e-mail address [sic] that may be contacted. The Client Do-Not-Contact Application compares the received list with the Client Do-Not-Contact List and returns the modified list that contain [sic] hashed e-mail addresses not present in the Client Do-Not-Contact List and are permitted for communication.” (Office action, p. 6.) It appears that the Office action is suggesting that Prince’s Client Application is the same thing as the claimed “third entity” and that Prince’s Client is the same thing as the claimed “first entity.” Initially, Applicants submit that Prince’s Client and Client Application are one-and-the-same entity. (Paragraph 33 states that “The Client Do-Not-Contact List Applications (400) in

FIG. 1 are deployed on multiple remote computers of individuals or businesses ('clients').") Thus, while paragraph 39 appears to state that the Client and Client Do-Not-Contact List Application may be hosted on two machines, such a hosting arrangement does not mean that the Client and Client Do-Not-Contact List Application are two different entities. Notwithstanding Applicants' belief that Prince's Client and the Client Application are one-and-the-same entity, nothing in paragraph 39 suggests that a different entity (i.e., the claimed "second entity") is the source of the e-mail message. As set forth at least twice above, Prince's Client (i.e., e-mail marketer) appears to be the source of the e-mail message and the compiler of the Client Do-Not-Contact List. Because this paragraph also fails to consider the claimed interplay of three entities as claimed by Applicants, the rejection constitutes clear error on behalf of the Examiner.

***B. THE ADVANTAGES PROVIDED BY APPLICANTS ARE UNATTAINABLE BY PRINCE.***

Among the many advantages recognizable from Applicants' claim 64 is that: (1) an entity (such as the claimed "second entity") can rely on the services of two different entities (such as the claimed "first entity" and "third entity") to send an e-mail message to a targeted audience without violating any requests to be exempted from such messages; and (2) an entity (such as the claimed "third entity") can maintain a Should Not Send List separate and apart from the entity that provides the Can Send List (such as the first entity), thereby avoiding any misuse by the first entity of the Should Not Send List. Applicants submit that neither advantage is recognizable by Prince.

Prince is incapable of recognizing either advantage for the simple reason that the same entity (i.e., the Client) is taught in Prince to be: (1) the provider of a Can Send List; (2) the creator of a Should Not Sent List (or, in the terms of Prince, the Client Do-Not-Contact List); (3) the remover of entries in the Should Not Sent List that are also present in the Can Send List; and

(4) the originator of the e-mail message. (Paragraphs 33 and 59.) Consequently, Prince appears to be incapable of allowing an entity (such as the second entity) to rely on the services of two different entities (such as the first and third entities) to send an e-mail message to a targeted audience without violating any requests to be exempted from such messages. Similarly, Prince appears to be incapable of allowing an entity (e.g., the claimed “third entity”) to maintain a Should Not Send List separate and apart from the entity that provides the Can Send List (e.g., the claimed “first entity”), thereby avoiding any misuse of the Should Not Send List. For example, such misuse may occur were an unscrupulous e-mail marketer to access the Should Not Send List (or, in the terms of Prince, the Client Do-Not-Contact List) and send e-mail messages to individuals on such list.

***C. APPLICANTS REDUCED THE CLAIMED INVENTION TO PRACTICE PRIOR TO THE EARLIEST EFFECTIVE DATE OF PRINCE.***

Submitted herewith are declarations under 37 C.F.R. § 131, each signed by one of the four inventors. Each of the declarations set forth facts establishing that the claimed invention was reduced to practice prior to the earliest effective date of Prince, January 23, 2003. Accordingly, Prince no longer qualifies as prior art under 35 U.S.C. § 102(e). For at least this reason, in addition to those set forth above, the claims are believed to be in condition for allowance.

Applicants respectfully submit that the declarations were not previously filed with the U.S. Patent Office because of its consistent and presently maintained good faith belief that Prince does not anticipate any of the claims of the pending application. In other words, Applicants believed in good faith that each of its amendments and responses previously filed with the Patent Office put the pending application in condition for allowance, thereby rendering moot the need for such declarations prior to the date of this filing.

**CLAIMS 65-69**

Dependent claims are dependent on independent claim 60 and are further believed to add novel, non-obvious, and patentable subject matter. For at least these reasons, Applicants submit that they are also in condition for allowance.

**CLAIMS 70-105**

The Office Action generally states that “[c]laims 70-105 do not teach or define any new limitation above claims 64-69 therefore, they are rejected for similar reasons.” (Office action, p. 4.) Applicants respectfully disagree. For example, claim 86 claims, among other things, “transmitting, by said first entity, said first list of hash coded e-mail addresses to an e-mail address filtration service provider; transmitting, by said second entity, said second set of hash coded e-mail addresses to said e-mail address filtration service provider.” Prince, as best understood, does not teach, describe, or suggest a filtration service provider, and even if something within Prince could be interpreted as a filtration service provider, Prince, as best understood, certainly does not teach transmitting a first list of hash coded e-mail addresses representing e-mail addresses to which an e-mail message could be sent and transmitting a second list of hash coded e-mail addresses representing e-mail addresses to which an e-mail message should not be sent to the filtration service provider, as claimed. Therefore, Applicants respectfully submit that claims 70-105 are in condition for allowance for at least the relevant reasons stated above.



Applicants respectfully submit that the claims are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

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